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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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08/450,437 05/25/95 FARINA

C P30958C2

12M1/1216

NORA STEIN-FERNANDEZ  
SMITHKLINE BEECHAM CORPORATION  
CORPATE PATENTS U S UW2220  
P O BOX 1539  
KING OF PRUSSIA PA 19406-0939

EXAMINER

MULLIS, J

ART UNIT

PAPER NUMBER

1207

5

DATE MAILED:

12/16/96

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) 12, 13 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11, 14-16 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

Art Unit: 1207

Applicant's election with traverse of Groups I and III are species of Example 85 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the inventions have common utility and are related and have a common core nucleus and that undue burden of search does not exist. This is not found persuasive because undue burden of search exists since the search for the two groups is not coextensive as shown by their different classifications. Restriction has not been required based on different classification.

The requirement is still deemed proper and is therefore made FINAL.

Applicants abstract is deficient since it does not define the substituents. Correction is required.

Claim 2 does not end in a period. Claim 2 recites "a C<sub>5-7</sub>".  
Correction is required.

Claims 1-11 and 14-16 are objected to in that claim 1 is not in the form of a single complete sentence and is therefore improper in that claim 1 contains more than 1 period. Note MPEP 608.01(m) and Fressola v. Manbeck cited herein.

Art Unit: 1207

Claims 1-10 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

The term "optionally" can be interpreted as applying only to the first and named member of the Markush group in which "optionally" appears or may be interpreted as applying to the whole Markush group and this term is therefore ambiguous as applicants are using this term. For instance in claim 1 does the "optionally substituted phenyl, naphthyl or C<sub>5-7</sub> cycloalkdienyl group" include optionally substituted naphthyl or only optionally substituted phenyl?

It is not clear if the material in parenthesis are meant to be examples or definitions. For example in claim 15 the phrase "food intake inhibition" in the phrase "eating disorders (food intake inhibition)" define the term "eating disorder" or is it merely an example of an eating disorder?

Art Unit: 1207

Claims 9-11 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

Claims 9-11 are broader than claim 1 from which these claims ultimately depend in that claim 1 does not <sup>require</sup> ~~require~~ that R<sub>5</sub> may be Ar.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States:

Claims 1-11 and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Mishra et al. article.

Art Unit: 1207

Mishra discloses aa compound for treatment of inflammation which is identical to applicants quinolines wherein applicants group  $R_5$  is phenyl,  $R_3$  and  $R_4$  are hydrogen, X is oxygen and R and  $R_1$  are hydrogen and Ar is substituted aromatic. ~~Note the abstract and Table 1.~~ Although nothing is disclosed regarding substitution of Ar solely by alkyl as in instant claim 2, substitution of Ar by moieties other than alkyl is not excluded by this claim. Although the material of the reference would be inherently racemic, claim 10 does not exclude the enantiomer of "(1b)".

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine is (703) 308-4556 or (703) 305-4556.

Any inquiry concerning this communication should be directed to Examiner Jeffrey Mullis at telephone number (703) 308-2820.

MULLIS; acs  
December 12, 1996

JEFFREY C. MULLIS  
PRIMARY EXAMINER  
GROUP 1200

